

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appellants: Marc PREAUDAT et al.

Examiner: SHEN, Bin

Serial No.: 10/522,909

Group Art Unit: 1657

Filed: October 5, 2005

Confirmation No.: 7128

Title: METHOD FOR DETERMINING ENDOGLYCOSIDASE ENZYME ACTIVITY

**REQUEST FOR WITHDRAWAL OF IMPROPER HOLDING OF ABANDONMENT**

Mail Stop  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Under item 1 of the Notice of Abandonment mailed September 10, 2008, it is alleged that the above-identified application has been abandoned in view of Applicant's failure to timely file a response to the Office letter mailed December 21, 2007. This contention is respectfully traversed.

Attached is a copy of the firm's computer records (on ProLaw) for the above-identified application (Attorney Docket No.: LOM-0047). Applicant respectfully submits that no such communication was ever received from the USPTO. The most recent communication received from the USPTO was the Examiner's Answer (mailed: November 27, 2007) to Applicants' Brief on Appeal filed September 24, 2007. Upon receipt of the Examiner's Answer on November 30, 2007, the docketing clerk duly created an entry for Reply Brief/Oral Hearing having a due date of January 27, 2008. On January 25, 2008, Applicants filed a request for oral hearing, which did not include a Reply Brief. It should be noted that appellant is not required to file a reply brief to respond to an examiner's answer or a supplemental examiner's answer. Accordingly, the case should have been forwarded to the Board for decision on the appeal in accordance with MPEP §1208 (See, under "Section I. Reply Brief"). Since such was not performed, the holding of abandonment is improper, and should be reversed.

In any event, Applicant has obtained the aforementioned communication via Patent Application Information Retrieval (PAIR), which is classified therein as "Miscellaneous Action

with SSP." A copy of this communication is enclosed herewith for the PTO's review. Suffice to say, the communication appears to be incomplete, and more importantly, does not identify any issues/matters that the Examiner deems to be pertinent (for a supplemental Examiner's Answer). Nor does it set any time period for response. Thus the undersigned cannot file copies of records on which such dates would have been noted. As such, it is respectfully submitted that the Notice of Abandonment is without merit. Favorable action is earnestly solicited.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 133402.

Respectfully submitted,

/Anthony J. Zelano/

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Anthony J. Zelano, Reg. No. 27,969  
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Attorney Docket No.: LOM-0047

Date: September 25, 2008

Encl.:

- (1) Firm's computer docket records for LOM-0043
- (2) A copy of the Office letter mailed December 21, 2007

# **EXHIBIT A**

start 0 1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30 31 32 33 34 35 36 37 38 39 40 41 42 43 44 45 46 47 48 49 50 51 52 53 54 55 56 57 58 59 60 61 62 63 64 65 66 67 68 69 70 71 72 73 74 75 76 77 78 79 80 81 82 83 84 85 86 87 88 89 90 91 92 93 94 95 96 97 98 99

# **EXHIBIT B**



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,909	10/05/2005	Marc Preaudat	LOM-0047	7128
23599 7590 12/21/2007 MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			EXAMINER SHEN, BIN	
			ART UNIT 1657	PAPER NUMBER
			MAIL DATE 12/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**UNITED STATES DEPARTMENT OF COMMERCE****U.S. Patent and Trademark Office**

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
10522909	10/5/2005	PREAUDAT ET AL.	LOM-0047

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**EXAMINER**

Bin Shen

**ART UNIT****PAPER**

1657

20071217

**DATE MAILED:**

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner for Patents****Examiner's Answer****(8) Evidence Relied Upon**

1. Bazin et al. Homogeneous time resolved fluorescence resonance energy transfer using rare earth cryptates as a tool for probing molecular interactions in biology. Spectrochimica Acta Part A 2001;(57):2197-2211.
2. Nicolson et al. USPN 4859581 August 22, 1989.

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Examiner is not aware of any related proceedings.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

The appeal involves claims 1-18 are pending, of which claims 1, 2, 5-12 stand rejected. Claims 3, 4, 13-18 are withdrawn. Claims 1, 2, 5-12 are subject to the present appeal.

(4) Status of Amendments After Final

There are no pending amendments.

(5) Summary of Claimed Subject Matter

The summary of invention contained in the brief is correct.

(6) Grounds of Rejection to be reviewed on Appeal

The Appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

1. Bazin et al. Spectrochimica Acta Part A 2001;57:2197-2211.

2. Nicolson et al. USPN4859581.

*name, number & date*  
*08-22-1989*

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-2, 5-12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Bazin et al.

(Spectrochimica Acta Part A 2001;57:2197-2211) in view of Nicolson et al. (USPN4859581).

Bazin et al. teach FRET-based enzyme assays using a class of fluorescent complexes, the rare earth cryptate, as a